

REMARKS

This paper is submitted in response to the Office Action. Claims 6, 12, 18, 21, and 24 are amended. Claims 1-26 are pending, of which claims 1, 9, 15, and 21 are independent. Applicants respectfully request reconsideration of the application in view of the above amendments to the claims and the following remarks. For Examiner's convenience and reference, Applicants present remarks in the order that the Office Action raises the corresponding issues.

In connection with the prosecution of this case and any related cases, Applicants have, and/or may, discuss various aspects of the disclosure of the cited references as those references are then understood by the Applicants. Because such discussion could reflect an incomplete or incorrect understanding of one or more of the references, the position of the Applicants with respect to a reference is not necessarily fixed or irrevocable. Applicants thus hereby reserve the right, both during and after prosecution of this case, to modify the views expressed with regard to any reference.

Please note that Applicants do not intend the following remarks to be an exhaustive enumeration of the distinctions between any cited references and the claims. Rather, Applicants present the distinctions below solely by way of example to illustrate some of the differences between the claims and the cited references. Finally, Applicants request that Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of any reference is consistent with Examiner's understanding.

Unless otherwise explicitly stated, the term "Applicants" is used herein generically and may refer to a single inventor, a set of inventors, an appropriate assignee, or any other entity or person with authority to prosecute this application.

Rejection under 35 U.S.C §103(a)

The Office action rejects claims 1-4 and 8 under 35 U.S.C §103(a) over *Leong et al.* (U.S. Patent No. 6,707,794) in view of *Anderson et al.* (U.S. Patent No. 5,850,388)¹ and rejects claims 5-7 and 9-26 under 35 U.S.C §103(a) over *Leong et al.* in view of *Anderson et al.*, as applied to claim 1 above, and in further view of *Grace* (U.S. Patent No. 5,748,098).

Under 35 U.S.C §103(a), “[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” According to MPEP §2142, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” Moreover, the Examiner must establish that the references teach or suggest each and every claim element or explain “why the difference(s) between the prior art and the claimed invention would have been obvious.”²

With respect to claims 1 and 15, the Examiner cited Figure 1 of *Leong* in alleging that *Leong* teaches “a first link analyzer (152, FIG. 1, col. 1, lines 50-56)...disposed in an in-line arrangement with respect to a first data stream (col. 1 lines 54-56) corresponding to a first communication protocol (112; FIG. 1; col. 1, lines 45-47),” and a “second link analyzer (150, FIG. 1, lines 50-56)...disposed in an in-line arrangement with respect to a second data stream corresponding to a second communication protocol (FIG. 1; where the Ethernet is the second communication protocol) that is different from the first communication protocol.” *See Office Action*, pp. 3, 6, and 7. Applicants respectfully disagree.

¹ Because *Leong* is only citable under 35 U.S.C. §102(e), Applicants do not admit that *Leong* is in fact prior art with respect to any or all of the claims of the present application, but rather reserve the right to swear behind *Leong* in this application or a divisional, continuation, or CIP thereof, thereby removing it as a reference.

² MPEP §2143.03 (“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970.”); MPEP §2141.III (“The prior art reference (or references when combined) need not teach or suggest all the claim limitations, however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.”)

As shown in Figure 1 of *Leong*, which is reproduced below with annotations for the Examiner's convenience, both of the analysis agents 150 and 152 are located in Ethernet local area networks (LANs) 106 and 108 (circled for emphasis), respectively.

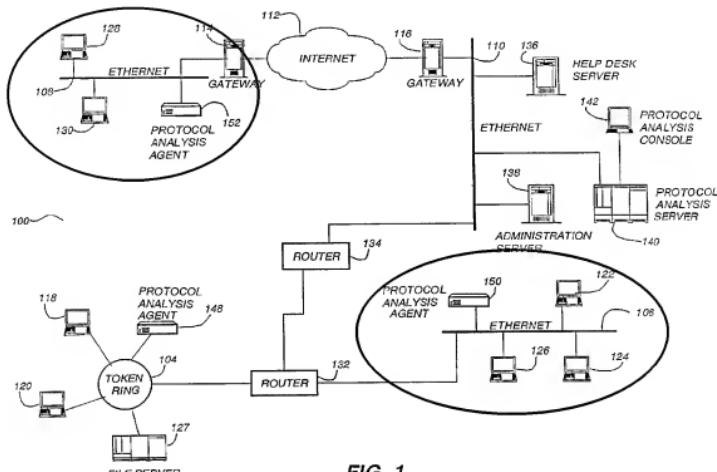


FIG. 1

The internet 112, along with the gateway devices 114 and 116, couples the LAN 108 to the other LANs 104, 106, and 110. *See Leong*, col. 1, lines 42-46. Thus, contrary the Examiner's assertion, analysis agent 152 is not "disposed in an in-line arrangement with respect to a first data stream corresponding to an [Internet 112] communication protocol," nor is any one of analysis agents/servers 140, 148, and 150. Instead, the analysis agents/servers (also referred to as "protocol analyzers") capture "auto-negotiation ordered sets generated by two nodes attempting to establish a link over Gigabit Ethernet." *See Leong*, col. 4, lines 56-65 (emphasis added).

In light of the foregoing discussion, the rejection of claims 1 and 15 is based on a mischaracterization of *Leong* and thus lacks an adequate foundation. The Examiner rejected claim 9 "for the same reasons as claim 1 and 5 above" and rejected claim 21 "for the same reasons as claim 9 above." *See Office Action*, pp. 6 and 8. Therefore, inasmuch as the rejection

of claim 1 lacks as an adequate foundation, for the reasons discussed above, the rejection of claims 9 and 21 also lacks an adequate foundation and should be withdrawn. Moreover, dependent claims 2-8, 10-14, 16-20, and 22-26 are allowable at least by virtue of their dependence from one of allowable claims 1, 9, 15, and 21. Accordingly, withdrawal of the rejection of dependent claims 2-8, 10-14, 16-20, and 22-26 is respectfully requested.

Charge Authorization

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are allowable. In the event that Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview or overcome by an Examiner's Amendment, Examiner is requested to contact the undersigned attorney.

Dated this 9th day of April, 2009.

Respectfully submitted,

/Ronald J. Ward/Reg. No. 54,870

RONALD J. WARD
Registration No. 54,870
ERIC L. MASCHOFF
Registration No. 36,596
Attorneys for Applicant
Customer No. 022913
Telephone: (801) 533-9800

RJW:jbh
2325859_1